

REMARKS

Upon entry of the claim amendments, claims 3-19 will be all the claims pending in the application.

Regarding amended claim 4, the description at page 9, line 16, through page 10, line 1, supports the fact that the water-soluble polymer recited in claim 4 is in addition to the at least one of the amide-denatured polyvinyl alcohol and diacetone-denatured polyvinyl alcohol.

New independent claim 18 is supported by original claims 1 and 2.

New claim 19 is directed to particular embodiments of the invention wherein overcoat layer (B) is free of inorganic pigment. Support for new claim 19 can be found at, for example, the description at page 38 of the specification relating to the preparation of a layer (B) for Example 10.

No new matter has been added. In this regard, the fundamental factual inquiry is whether a claim defines an invention that was clearly conveyed to those skilled in the art at the time the application was filed. Ralston Purina Co. v. Far-Mar-Co., Inc., 227 USPQ 177, 179 (Fed. Cir. 1985). The subject matter of the claim need not be described literally, *i.e.* using the same terms or *in haec verba*, in order for the disclosure to satisfy the description requirement (*see*, MPEP §2163.02). In the present case, the specification makes clear that a thermal recording material, including an overcoat layer (B) free of inorganic pigment, is part of Applicants' invention.

Referring to the §112, second paragraph, rejection of claims 2, 4, and 6 at Section No. 1, page 2, of the Action, Applicants have amended the claims as shown and explained above. It is submitted that the amended claims fully satisfy the requirements of §112, and the withdrawal of this rejection is respectfully requested.

Referring to the prior art rejections at Section Nos. 2-5, pages 2-3, of the Action, the prior art does not disclose the thermal recording material of independent claim 18. In particular, the prior art fails to disclose a thermal recording material comprising a protective layer comprising an overcoat layer (A) and another overcoat layer (B). The principal constituents of layer (A) are

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inorganic pigment and water-soluble polymer. The principal constituents of layer (B) are lubricant and another water-soluble polymer.

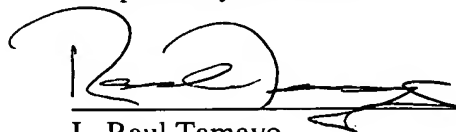
The claimed invention would not have been obvious from Fukuchi. As demonstrated in the present specification, the present invention provides several unexpectedly superior results in sensitivity, plasticizer resistance, run in printing system, rubbing resistance, and printability. Any one of these unexpected results serves to rebut an alleged case of obviousness.

Furthermore, Fukuchi discloses an intermediate layer and a glossing layer. Fukuchi's glossing layer necessarily requires an inorganic pigment as a main component thereof. Column 2, lines 30-51. As recited in claim 19, according to certain embodiments of the invention, overcoat layer (B) is free of inorganic pigment.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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